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PATENT APPLICATION

ATTORNEY DOCKET NO. 100203960-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): David H. HANES

Confirmation No.: 6734

Application No.: 10/753,251

Examiner: Adegeye, Oluwaseun

Filing Date: January 8, 2004

Group Art Unit: 2621

Title: SYSTEM, METHOD, AND COMPUTER-READABLE MEDIUM FOR ANALYZING AN MPEG-FORMATTED FILE

Mail Stop Appeal Brief-Patents
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PO Box 1450
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TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on February 25, 2008.

☒ The fee for filing this Appeal Brief is \$510.00 (37 CFR 41.20).

☐ No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$460

☐ 3rd Month
\$1050

☐ 4th Month
\$1640

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 510. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: David H. HANES Confirmation No.: 6734
Serial No.: 10/753,251
Filing Date: January 8, 2004
Group Art Unit: 2621
Examiner: Adegeye, Oluwaseun
Title: SYSTEM, METHOD, AND COMPUTER-READABLE
MEDIUM FOR ANALYZING AN MPEG-FORMATTED FILE
Docket No.: 100203960-1

MAIL STOP: APPEAL BRIEF PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Appellant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed January 2, 2008, finally rejecting Claims 1-26. Appellant filed a Notice of Appeal on February 25, 2008. Appellant respectfully submits herewith this Appeal Brief with authorization to charge the statutory fee of \$510.00.

REAL PARTY IN INTEREST

The present application was assigned to Hewlett-Packard Development Company, L.P. as indicated by an assignment from the inventor recorded on December 29, 2003 in the Assignment Records of the United States Patent and Trademark Office at Reel 014516, Frame 0901. The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-26 stand rejected pursuant to a final Office Action mailed January 2, 2008. Claims 1-26 are presented for appeal.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the mailing of the Final Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of the present invention as defined by independent Claim 1 are directed toward a method of analyzing a moving pictures expert group (MPEG)-formatted video/audio file (175), comprising defining a rule (123) comprising at least one parameter (123A.sub.1) that logically defines a format requirement for determining whether the MPEG-formatted file is decodable on a first type of MPEG-capable decoder (123B.sub.1) but not decodable on a second type of MPEG-capable decoder

(123B.sub.N); reading a portion of the file (70, 60, 50A, or 80); comparing the portion of the file with the rule (123); and determining whether the file violates the rule (126.sub.4) (*Specification*, at least on p. 7, line 16 – p. 8, line 23).

Embodiments of the present invention as defined by independent Claim 10 are directed toward a system (100) for analyzing a moving pictures expert group (MPEG)-formatted file (175), comprising: a format analysis application (122); and a processing element (130) operable to execute the application, the application reading a rule (123) having at least one logical instruction defining a format requirement (123A.sub.1) for determining whether the MPEG-formatted file is decodable on a first type of MPEG-capable decoder (123B.sub.1) but not decodable on a second type of MPEG-capable decoder (123B.sub.N), the application (122) comparing a portion of the file (70, 60, 50A, or 80) with the rule (123), a determination of compatibility of the file with the second type of MPEG-capable decoder made dependent upon a result of the comparison (126.sub.4) (*Specification*, at least on p. 7, line 16 – p. 8, line 23).

Embodiments of the present invention as defined by independent Claim 18 are directed toward a computer-readable medium having stored thereon an instruction set to be executed, the instruction set, when executed by a processor (130), causes the processor to: read a rule (122) comprising a parameter logically defining a format requirement (123A.sub.1) for determining whether a moving pictures expert group (MPEG)-formatted file is decodable on a first type of MPEG-capable decoder (123B.sub.1) but not decodable on a second type of MPEG-capable decoder (123B.sub.N); read a portion of the MPEG-formatted file (70, 60, 50A, or 80); compare the portion with the parameter; and determine whether the portion violates the rule (126.sub.4) (*Specification*, at least on p. 7, line 16 – p. 9, line 3).

Embodiments of the present invention as defined by independent Claim 25 are directed toward a system for analyzing a moving pictures expert group (MPEG)-formatted file (175), comprising a format analysis application (122); and a processing element (130) operable to execute the application, the application reading a rule (123) having at least one logical instruction defining a digital versatile disc (DVD) format

requirement (123A.sub.1), the rule specifying a particular portion of the file to be tested by the rule (70, 60, 50A, or 80), and the application comparing the specified portion of the file with the rule, the application making a determination of validity of the file with the DVD format dependent upon a result of the comparison (126.sub.4) (*Specification*, at least on p. 7, line 16 – p. 8, line 23).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 4-5, 7-11, 14-16, 18-19, 21-23, and 25-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,973,130 issued to Wee et al. (hereinafter "*Wee*") in view of U.S. Patent Publication No. 2004/0136352 issued to Fu et al. (hereinafter "*Fu*").

2. Claims 2, 3, and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Wee* in view of *Fu* as applied to claims 1, 10, 18, and 25, and further in view of U.S. Patent Publication No. 2002/0044760 issued to Shirakawa et al. (hereinafter "*Shirakawa*").

3. Claims 6, 12, and 20 were rejected under 35 USC §103(a) as being unpatentable over *Wee* in view of *Fu* as applied to claims 1, 10, 18, and 25, and further in view of U.S. Patent Publication No. 2001/0026511 issued to Ueda et al. (hereinafter "*Ueda*").

4. Claims 17 and 24 were rejected under 35 USC §103(a) as being unpatentable over *Wee* in view of *Fu* as applied to claims 1, 10, 18, and 25 above and further in view of U.S. Patent Publication No. 2002/0169742 issued to Nakamura et al. (hereinafter "*Nakamura*").

ARGUMENT

A. Standard

1. 35 U.S.C. § 103

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary

skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *Id.* Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Additionally, not only must there be a suggestion to combine the functional or operational aspects of the combined references, but also the prior art is required to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1183 (Fed. Cir. 1991). Moreover, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

B. Argument

1. Rejection under 35 U.S.C. §103(a) in view of *Wee* and *Fu*

Claims 1, 4-5, 7-11, 14-16, 18-19, 21-23, and 25-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Wee* in view of *Fu*.

Of the rejected claims, in this grouping of claims, Claims 1, 10, 18, and 25 are independent. Appellant respectfully submits that each of independent Claims 1, 10, 18, and 25 are patentable over the cited references. For example, Appellant respectfully submits that neither *Wee* nor *Fu*, alone or in combination, discloses, teaches or suggests all the limitations of independent Claim 1. For example, neither *Wee* nor *Fu*, alone or in combination, discloses or suggests "defining a rule comprising at least one parameter that logically defines a format requirement for determining whether the MPEG-formatted file is decodable on a first type of MPEG-capable decoder but not decodable on a second type of MPEG-capable decoder; reading a portion of the file; comparing the portion of

the file with the rule; and determining whether the file violates the rule" as recited in Claim 1 (emphasis added).

Wee appears to disclose a method for encoding regions of an MPEG file to permit automatic identification of an object through multiple frames and for select decoding and extraction of that object, without necessarily decoding all irrelevant image data (*Wee*, Abstract). The Examiner admits *Wee*, and Appellant agrees, that *Wee* does not appear to disclose or even suggest "defining a rule comprising at least one parameter that logically defines a format requirement for determining whether the MPEG-formatted file is decodable on a first type of MPEG-capable decoder but not decodable on a second type of MPEG-capable decoder" (Office Action, page 3) (emphasis added).

The Examiner appears to rely on *Fu* to purportedly disclose defining a rule comprising at least one parameter that logically defines a format requirement for determining whether the MPEG-formatted file (see [37] and [39]) is decodable on a first type of MPEG-capable decoder but not decodable on a second type of MPEG-capable decoder (see [025]) (Office action, page 3). Appellant respectfully disagrees.

Fu appears to disclose an MPEG encoding system configured to format a video/audio signal into an MPEG format (*Fu*, pars. [0037] – [0039]). Thus, *Fu* appears to disclose a method for converting a proprietary direct satellite system (DSS) transport stream used by DirecTV to a digital video broadcast (DVB) standard MPEG transport streams supported by a set-top box (*Fu*, Title, Abstract, and par. 0007- par. 0009). In other words, *Fu* appears to be disclosing that non-MPEG formatted files such as direct satellite system (DSS) encoded files are converted to MPEG format for use by set-top boxes. *Fu* discloses that "the type of encoding may determine whether another system will be able to decode and interpret a received MPEG data stream" (*Fu*, par. [0025]). However, *Fu* does not appear to disclose or even suggest, in the portions cited by the Examiner or in any other portion, that *once the converted file is in MPEG format*

that a rule is defined or used for determining whether the MPEG-formatted file is decodable on a first type of MPEG-capable decoder but not decodable on a second type of MPEG-capable decoder. Accordingly, the combination of *Wee* and *Fu* does not appear to disclose or even suggest each and every limitation of Claim 1. Therefore, Claim 1 is patentable over the cited references.

Independent Claims 10, 18, and 25 recite similar limitations as recited in Claim 1. At least for the reasons discussed above in connection with independent Claim 1, Appellant respectfully submits that Claims 10, 18, and 25 are also patentable over the cited references.

Claims 4-5, 7-9, 11, 14-16, 19, 21-23, and 26 depend respectively from independent Claims 1, 10, 18, and 25. Therefore, for at least for the reasons discussed above, Claims 4-5, 7-9, 11, 14-16, 19, 21-23, and 26 are also patentable. Accordingly, Appellant respectfully requests the allowance of Claims 1, 4-5, 7-11, 14-16, 18-19, 21-23, and 25-26.

2. Rejection under 35 U.S.C. §103(a) in view of *Wee*, *Fu*, and *Shirakawa*

Claims 2, 3, and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Wee* in view of *Fu* as applied to claims 1, 10, 18, and 25, and further in view of *Shirakawa*.

Claims 2, 3, and 13 depend from respective independent Claims 1 and 10. As shown above, Claims 1 and 10 are patentable over the combination of *Wee* and *Fu*. Further, *Shirakawa* does not appear to remedy at least the deficiencies of *Wee* and *Fu* discussed above. Therefore, Appellant respectfully requests that the rejection of Claims 2, 3, and 13 be withdrawn.

3. Rejection under 35 U.S.C. §103(a) in view of *Wee*, *Fu*, and *Ueda*

Claims 6, 12, and 20 were rejected under 35 USC §103(a) as being unpatentable over *Wee* in view of *Fu* as applied to claims 1, 10, 18, and 25, and further in view of *Ueda*.

Claims 6, 12, and 20 depend from respective independent Claims 1 and 10. As shown above, Claims 1 and 10 are patentable over the combination of *Wee* and *Fu*. Further, *Ueda* does not appear to remedy at least the deficiencies of *Wee* and *Fu* discussed above. Therefore, Appellant respectfully requests that the rejection of Claims 6, 12, and 20 be withdrawn.

4. Rejection under 35 U.S.C. §103(a) in view of *Wee*, *Fu*, and *Nakamura*

Claims 17 and 24 were rejected under 35 USC §103(a) as being unpatentable over *Wee* in view of *Fu* as applied to claims 1, 10, 18, and 25 above and further in view of *Nakamura*.

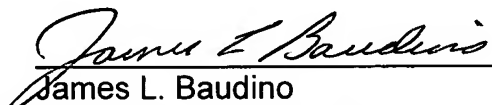
Claims 17 and 24 depend from independent Claims 10. As shown above, Claims 10 is patentable over the combination of *Wee* and *Fu*. Further, *Shirakawa* does not appear to remedy at least the deficiencies of *Wee* and *Fu* discussed above. Therefore, Appellant respectfully requests that the rejection of Claims 17 and 24 be withdrawn.

CONCLUSION

Appellant has demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is authorized to charge the statutory fee of \$510.00 to Deposit Account No. 08-2025 of Hewlett-Packard Company. Although no other fee is believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,


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Date: March 11, 2008

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CLAIMS APPENDIX

1. A method of analyzing a moving pictures expert group (MPEG)-formatted video/audio file, comprising:

defining a rule comprising at least one parameter that logically defines a format requirement for determining whether the MPEG-formatted file is decodable on a first type of MPEG-capable decoder but not decodable on a second type of MPEG-capable decoder;

reading a portion of the file;

comparing the portion of the file with the rule; and

determining whether the file violates the rule.

2. The method according to claim 1, wherein defining a rule further comprises defining a rule that comprises a parameter for addressing the portion of the file.

3. The method according to claim 2, wherein defining a rule that comprises a parameter for addressing the portion further comprises defining a rule that comprises a parameter specifying a bit rate of the file.

4. The method according to claim 1, wherein defining a rule comprises defining a rule having at least one parameter logically defining a standardized format requirement.

5. The method according to claim 1, wherein defining a rule comprises defining a rule having at least one parameter logically defining a MPEG format requirement.

6. The method according to claim 1, wherein defining a rule comprises defining a rule having at least one parameter logically defining a digital versatile disc (DVD) format requirement.

7. The method according to claim 1, wherein reading a portion of the file comprises locating a sequence header of the file.

8. The method according to claim 1, wherein comparing the portion of the file comprises determining whether the file comprises a group of pictures (GOP) header.

9. The method according to claim 1, further comprising transcoding the file upon determining the file violates the rule.

10. A system for analyzing a moving pictures expert group (MPEG)-formatted file, comprising:

a format analysis application; and

a processing element operable to execute the application, the application reading a rule having at least one logical instruction defining a format requirement for determining whether the MPEG-formatted file is decodable on a first type of MPEG-capable decoder but not decodable on a second type of MPEG-capable decoder, the application comparing a portion of the file with the rule, a determination of compatibility of the file with the second type of MPEG-capable decoder made dependent upon a result of the comparison.

11. The system according to claim 10, wherein the rule comprises at least one logical instruction defining a moving pictures expert group (MPEG) format requirement.

12. The system according to claim 10, wherein the rule comprises at least one logical instruction defining a digital versatile disc (DVD) format requirement.

13. The system according to claim 10, wherein the application is adapted to compare a bit rate of the file with the rule.

14. The system according to claim 10, wherein the application is adapted to determine whether the file comprises a group of pictures (GOP) header.

15. The system according to claim 10, wherein the application is adapted to transcode the file upon determining the file violates the rule.

16. The system according to claim 10, wherein the application is adapted to read the file to determine a location of a sequence header of the file.

17. The system according to claim 10, wherein the application is adapted to determine whether the file comprises a group of pictures disposed between a sequence start code and a sequence end code of the file.

18. A computer-readable medium having stored thereon an instruction set to be executed, the instruction set, when executed by a processor, causes the processor to:

read a rule comprising a parameter logically defining a format requirement for determining whether a moving pictures expert group (MPEG)-formatted file is decodable on a first type of MPEG-capable decoder but not decodable on a second type of MPEG-capable decoder;

read a portion of the MPEG-formatted file;

compare the portion with the parameter; and

determine whether the portion violates the rule.

19. The computer-readable medium according to claim 14, wherein the instruction set, when executed by the processor, causes the processor to read a rule logically defining a MPEG format requirement.

20. The computer-readable medium according to claim 14, wherein the instruction set, when executed by the processor, causes the processor to read a rule logically defining a digital versatile disc (DVD) format requirement.

21. The computer-readable medium according to claim 14, wherein the instruction set, when executed by the processor, causes the processor to determine whether the file comprises a group of pictures (GOP) header.

22. The computer-readable medium according to claim 14, wherein the instruction set, when executed by the processor, causes the processor to locate a sequence header of the file.

23. The computer readable medium according to claim 14, instruction set, when executed by the processor, causes the processor to transcode the file if the file violates the rule.

24. The computer-readable medium according to claim 14, wherein the instruction set, when executed by the processor, causes the processor to determine whether the file comprises a group of pictures disposed between a sequence start code and a sequence end code of the file.

25. A system for analyzing a moving pictures expert group (MPEG)-formatted file, comprising:

a format analysis application; and

a processing element operable to execute the application, the application reading a rule having at least one logical instruction defining a digital versatile disc (DVD) format requirement, the rule specifying a particular portion of the file to be tested by the rule, and the application comparing the specified portion of the file with the rule, the application making a determination of validity of the file with the DVD format dependent upon a result of the comparison.

26. The system of Claim 25, wherein the application is configured to transcode the file to comply with the rule in response to a determination that the specified portion of the file violates the rule.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None